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Robert W. Jewell

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EXAMINER

MORRISON, THOMAS A

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT W. JEWELL

Appeal 2008-1394
Application 10/624,779
Technology Center 3600

Decided: December 11, 2008

Before: WILLIAM F. PATE, III, STEVEN D.A. McCARTHY, and
MICHAEL W. O'NEILL, *Administrative Patent Judges.*

McCARTHY, *Administrative Patent Judge.*

DECISION ON APPEAL

1 The Appellant appeals under 35 U.S.C. § 134 (2002) from the final
2 rejection of claims 1-6, 9-16, 19-23, 25 and 26. We have jurisdiction under
3 35 U.S.C § 6(b) (2002). We AFFIRM.

4 The Appellant seeks to show that the Examiner erred in rejecting
5 claims 1-5, 10, 12, 13, 19-23, 25 and 26 under 35 U.S.C. § 102(b) (2002) as

1 being anticipated by Kajikawa (JP 56-113641 A, publ. Sep. 7, 1981);¹
2 rejecting claims 10 and 11 under § 102(b) as being anticipated by Mandel
3 (US 4,877,234, issued Oct. 31, 1989); rejecting claims 6, 11 and 14 under
4 35 U.S.C. § 103(a) (2002) as being unpatentable over Kajikawa and Laure
5 (US 4,717,027, issued Jan. 5, 1988); rejecting claims 9 and 15 under
6 § 103(a) as being unpatentable over Kajikawa and Hayashi (JP 59-245374,
7 publ. Jun. 12, 1986); and rejecting claim 16 under § 103(a) as being
8 unpatentable over Kajikawa and Harush (US 6,456,311 B1, issued Sep. 24,
9 2002).²

10 With respect to the rejection of claims 1-5, 10, 12, 13, 19-23, 25 and
11 26 under § 102(b), the Appellant contends that the Examiner erred in finding
12 that Kajikawa discloses parallel media carriers cause print media to rotate
13 towards and align against a registration wall. (*E.g.*, App. Br. 14). The
14 Examiner finds that Kajikawa teaches transporting belts meeting these
15 limitations. (Ans. 13).

16 The Appellant has grouped claims 1-5, 10, 12, 13, 19-23, 25 and 26
17 for purposes of arguing the rejection of the claims as being anticipated by
18 Kajikawa. The Appellant has grouped these claims by alleging that the
19 Examiner committed essentially the same error in rejecting each of the
20 independent claims (*See* App. Br. 12-22) and by presenting no separate
21 arguments regarding anticipation of the dependent claims by Kajikawa. *See*

¹ The record includes an English-language translation of Kajikawa. All page references to Kajikawa will be to the translation.

² Claims 17, 18 and 27-29 are withdrawn from consideration. Claims 7 and 8 are objected to as being dependent on the rejected base claim 6 but would be allowable if rewritten in independent form.

1 *In re Dillon*, 919 F.2d 688, 692 (Fed. Cir. 1990)(*en banc*). Although the
2 language of independent claims 1, 10, 12 and 19 is not identical, the
3 Appellant incorporates the explanation of the argument addressed to the
4 anticipation of claim 1 into the arguments addressed to the anticipation of
5 each of claims 10, 12 and 19 by Kajikawa. We select claim 1 as being
6 representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

7 Taking into account the language of representative claim 1, one issue
8 raised in this appeal is: Has the Appellant shown that the Examiner erred in
9 finding that Kajikawa discloses a plurality of parallel media carriers, “each
10 of the plurality of media carriers being configured to move print media at a
11 speed based on a position of each of the plurality of media carriers relative
12 to the registration wall to cause the print media to rotate towards and align
13 against the registration wall?”

14 The record supports the following findings of fact (FF) by a
15 preponderance of the evidence:

16 1. Kajikawa discloses a paper registering and transporting device.
17 (Kajikawa 4-5). Kajikawa’s device includes a registering reference surface
18 in the form of a wall. (Kajikawa 6). Kajikawa’s device also includes a pair
19 of transporting belts parallel to each other and to the registering reference
20 surface. (Kajikawa 5 and Fig. 3).

21 2. The Appellant’s Specification describes a speed differential
22 between two belts causing a print media to rotate and move towards a
23 registration wall. (Spec. 5, ¶ 0020). “For example, the print media will
24 rotate until an edge or side of the print media substantially abuts against the

1 registration wall 205 thereby causing the print media to substantially align
2 against the registration wall 205.” (*Id.*)

3 3. Kajikawa likewise discloses running a transport belt positioned
4 farther from the registering reference surface faster than a belt positioned
5 nearer to the surface. (Kajikawa 5-6 and Fig. 3). This speed differential
6 between Kajikawa’s two transporting belts tilts sheets of paper transported
7 by the belts toward the registering reference surface. (Kajikawa 7 and Fig.
8 3). Because of this, a sheet of paper taken from a paper sheet accumulating
9 section can be put against the registering reference surface immediately.
10 (Kajikawa 8). In other words, each of Kajikawa’s transporting belts is
11 configured to move the print media at a speeds based on its position (that is,
12 its distance) relative to the registration reference surface to cause the print
13 media to rotate towards the registration reference surface.

14 4. Kajikawa’s device includes a registering and feeding
15 mechanism mounted on the registering reference surface near the trailing
16 edge of one of the transporting belts. (Kajikawa 6 and Fig. 5). Kajikawa
17 teaches that the registration of the sheet of paper is finished within a short
18 distance because the sheet is registered by the registering and feeding
19 mechanism and the registering reference surface while the sheet is being
20 passed from the transporting belts to the registering and feeding mechanism.
21 (Kajikawa 8).

22 5. The speed differential between Kajikawa’s transporting belts
23 appears to cause print media such as sheets of paper to be put against the
24 registering reference surface in the same manner that the speed differential
25 between the Appellant’s belts causes print media to rotate toward and align

1 against a registration wall. In other words, each of Kajikawa's transporting
2 belts appears to be configured to align the print media against the registering
3 reference surface in the same manner that the Appellant's belts are
4 configured to perform this function. The Examiner has a reasonable basis
5 for belief (*see, e.g.*, Final Office Action, Oct. 20, 2005 at 11) that each of
6 Kajikawa's transporting belts is *configured* to move the print media at a
7 speed so as to collectively cause the print media to align against the
8 registering reference surface, even if Kajikawa's registering and feeding
9 mechanism actually aligns the sheets against the surface.

10 "To anticipate a claim, a prior art reference must disclose every
11 limitation of the claimed invention, either explicitly or inherently." *In re*
12 *Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). The Appellant does not
13 appear to contest that Kajikawa expressly discloses every limitation of claim
14 1 except that each of the plurality of media carriers is configured so as to
15 cause the print media to align against the registration wall. (*See* App. Br.
16 12-14 and Reply Br. 2-3). In other words, Kajikawa expressly discloses a
17 device substantially identical in structure to the claimed media registration
18 mechanism except that one characteristic of the configuration of the
19 transporting belts is not expressly disclosed.

20 Where a claimed device and a prior art device are substantially
21 identical, an examiner can require an applicant to prove that the prior art
22 device does not necessarily or inherently possess the characteristics of the
23 claimed device. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). The
24 Examiner has a reasonable basis for belief that Kajikawa's transporting belts
25 are each configured to move print media at a speed to cause the print media

1 to align against the registration wall. (FF 5). The Examiner's reasonable
2 belief shifts the burden to the Appellant to prove that at least one of the
3 transporting belts shown and described in Kajikawa is not necessarily
4 configured to cause the print media to align against the registering reference
5 surface.

6 The Appellant has not met this burden. Kajikawa's disclosure that
7 one may finish the registration of print media within a short distance by
8 combining the registering and feeding mechanism with the transporting belts
9 (FF 4) does not imply that the transporting belts would be incapable of
10 causing the print media to align against the registering reference surface
11 themselves in the absence of the registering and feeding mechanism. The
12 evidence that Kajikawa's transporting belts are configured to cause the print
13 media to align against the registering reference surface provided by (i) the
14 similarity in configuration between Kajikawa's belts and the belts described
15 in the Appellant's Specification (FF 5) and (ii) Kajikawa's statement that the
16 belts tilts sheets of paper so as to put the sheets against the registering
17 reference surface immediately after the sheets are taken from the paper
18 accumulating section (FF 3) outweighs any tendency of Kajikawa's
19 disclosure concerning the registering and feeding mechanism to prove the
20 opposite.

21 With respect to the rejection of claims 10 and 11 under § 102(b), the
22 Appellant contends that Mandel fails to disclose media carriers configured to
23 move a sheet of media in a direction substantially parallel to a fence. The
24 Appellant further contends that Mandel fails to disclose steering the sheet of
25 media towards the fence to cause an edge of the sheet of media to contact

1 and align against the fence. The Appellant advances these same contentions
2 in opposition to the rejection of both claims 10 and claim 11 under § 102(b)
3 as being anticipated by Mandel. (App. Br. 22). We select claim 10 as
4 representative of claims 10 and 11 for purposes of this ground of rejection.
5 § 41.37(c)(1)(vii).

6 The Examiner observes that the Appellant uses the word “comprising”
7 when defining which limitations are included in the media steering
8 mechanism of claim 10. Based on this usage, the Examiner concludes that
9 claim 10 is open-ended: That is, the Examiner concludes that the language
10 of claim 10 is broad enough to encompass media steering mechanisms
11 having structure other than the positively recited fence, plurality of media
12 carriers and drive mechanism which contributes to causing the edge of the
13 sheet of media to contact and align against the fence. (Ans. 22). The
14 Examiner finds that Mandel discloses a driven crowned roller and a driven
15 extension member configured to move a sheet of media in a direction
16 substantially parallel to a registration wall or fence. (Ans. 20-21). The
17 Examiner further finds that Mandel discloses a scuffer roller which
18 cooperates with the crowned roller and the extension member to cause the
19 edge of the sheet of media to contact and align against the fence. (Ans. 22-
20 23).

21 Taking into account the language of claim 10, two more issues raised
22 in this appeal are: Has the Appellant shown that the Examiner erred in
23 finding that Mandel discloses “a plurality of media carriers, each of the
24 media carriers configured to move the sheet of media in a direction
25 substantially parallel to the fence?” Has the Appellant shown that the

1 Examiner erred in finding that Mandel discloses “driving each of the media
2 carriers at different speeds . . . such that the sheet of media is steered
3 towards the fence to cause an edge of the sheet of media to contact and align
4 against the fence?”

5 The record supports the following additional findings of fact (FF) by a
6 preponderance of the evidence:

7 6. Mandel discloses a sheet turning and registration apparatus.
8 (Mandel, col. 2, ll. 31-33). Mandel’s apparatus includes two pairs of
9 crowned roll nip rollers. (*Id.*) One pair of nip rollers includes a driven
10 crowned roller and an idler roll. (Mandel, col. 2, ll. 52-56). The other pair
11 of nip rollers includes a driven extension member having a crowned end
12 portion and an idler roll. (*Id.*) Mandel’s apparatus also includes a
13 registration edge or wall. (Mandel, col. 3, ll. 3-6).

14 7. Mandel’s apparatus is adapted to either (i) turn and then register
15 sheets or (ii) pass and just register sheets. (Mandel, col. 2, ll. 56-57). For
16 example, the driven crowned roller and the driven extension member are
17 configured to revolve at the same speed to move a sheet of media in a
18 direction substantially parallel to the fence. (*See* Mandel, col. 3, ll. 21-22;
19 col. 3, ll. 9-12 (describing that the driven crowned roller and the driven
20 extension member revolve at the same speed when the extension member is
21 engaged) and Fig. 1). Even when turning and then registering sheets, the
22 driven crowned roller and extension member are configured to transport
23 each of the sheets for a short distance substantially parallel to the fence
24 before and after the sheet is turned. (*See* Mandel, col. 2, l. 37 and col. 2, l.
25 60 – col. 3, l. 1).

1 8. Mandel's apparatus includes drive mechanism including a drive
2 input or motor and a clutch/brake mechanism. (Mandel, col. 2, l. 60 – col. 3,
3 l. 1 and Fig. 2). When turning and then registering a sheet, Mandel's
4 clutch/brake mechanism brakes the extension member. The speed
5 differential between the driven crowned roller and the braked extension
6 member is such that the sheet of media is steered towards the fence. (*Id.*;
7 Mandel, Fig. 3). Mandel discloses that there is an inherent variation in the
8 90° turn performed in the nip rollers due to variations in roller speed and
9 clutch actuation time. Because of this variation, the apparatus must register
10 the sheet. (Mandel, col. 2, ll. 47-51). The steering of the sheet by the nip
11 rollers towards the fence causes an edge of the sheet of media to contact and
12 align against the fence by conducting the sheet into a skewed scuffer roller
13 which directs the edge of the sheet into alignment against the fence.
14 (Mandel, col. 3, ll. 12-20).

15 As noted earlier, a prior art reference anticipates a claim if the
16 reference discloses every limitation of the claimed invention, either
17 explicitly or inherently. *Schreiber*, 128 F.3d at 1477. A claim under
18 examination is given its broadest reasonable interpretation consistent with
19 the underlying specification when determining whether the subject matter of
20 the claim is either anticipated or obvious. *In re American Acad. of Science*
21 *Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Limitations not explicit or
22 inherent in the language of a claim cannot be imported from the
23 specification. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.
24 Cir. 2003).

1 Mandel discloses a sheet turning and registration apparatus including
2 a driven crowned roller and a driven extension member having a crowned
3 end portion, each of which is configured to move a sheet of media in a
4 direction substantially parallel to the fence. (FF 6 and 7). In particular,
5 claim 10 does not require each of the media carriers to be configured as
6 disclosed in the Specification to move a sheet of media in a direction
7 substantially parallel to a fence while the paper is steered towards the fence.
8 Mandel's crowned roller and extension member are each configured to move
9 a sheet of media in a direction substantially parallel to the fence before, after
10 and in lieu of turning the sheet to a right angle relative to the fence. (FF 7).

11 The Appellant recites in claim 10 that a drive mechanism drives each
12 of the media carriers at different speeds "such that the sheet of media is
13 steered towards the fence to cause an edge of the sheet of media to contact
14 and align against the fence." The proximity of the infinitive "to cause" to
15 the verb "steered" implies that the infinitive modifies the verb. In other
16 words, the quoted clause is broad enough to encompass media steering
17 mechanisms in which the steering of the sheet of media causes the edge of
18 the sheet to contact and align against the fence. The word "cause" in its
19 ordinary usage is broad enough to encompass indirect as well as direct
20 causation.

21 Mandel further discloses a drive mechanism for driving each of the
22 media carriers at different speeds such that the sheet of media is steered
23 toward the fence. (FF 8). The drive mechanism brakes the extension
24 member, creating a speed differential between the driven crowned roller and
25 the braked extension member. This speed differential is such that the sheet

1 rotates and the leading edge of the sheet is steered towards the fence. The
2 speed differential between the driven crowned roller and the braked
3 extension member directly causes the leading edge of the sheet to engage the
4 scuffer roller and the engagement of the sheet with the scuffer roller directly
5 causes the sheet to contact and align with the fence. (*Id.*) Although the
6 steering of the sheet towards the fence indirectly causes the edge of the sheet
7 to contact and align against the wall through the mediation of the scuffer
8 roller, the steering of the sheet towards the fence nonetheless causes "an
9 edge of the sheet of media to contact and align against the fence."

10 The foregoing analyses imply the following conclusions:

11 The Appellant has not shown that the Examiner erred in finding that
12 Kajikawa discloses a plurality of parallel media carriers, "each of the
13 plurality of media carriers being configured to move the print media at a
14 speed based on a position of each of the plurality of media carriers relative
15 to the registration wall to cause the print media to rotate towards and align
16 against the registration wall." The Appellant has not shown on the record
17 before us that the Examiner erred in rejecting grouped claims 1-5, 10, 12, 13,
18 19-23, 25 and 26 under § 102(b) as being anticipated by Kajikawa.

19 The Appellant has not shown that the Examiner erred in finding that
20 Mandel discloses a plurality of media carriers, "each configured to move the
21 sheet of media in a direction substantially parallel to the fence." In addition,
22 the Appellant has not shown that the Examiner erred in finding that Mandel
23 discloses "driving each of the media carriers at different speeds . . . such that
24 the sheet of media is steered towards the fence to cause an edge of the sheet
25 to contact and align against the fence." The Appellant has not shown on the

1 record before us that the Examiner erred in rejecting claims 10 and 11 under
2 § 102(b) as begin anticipated by Mandel.

3 The Appellant's sole contention regarding the rejections of claims 6,
4 9, 11 and 14-16 under § 103(a) is that Kajikawa fails to disclose or suggest
5 parallel media carriers configured to cause print media to align against a
6 registration wall; and that each of the secondary references Laure, Hayashi
7 and Harush likewise fails to teach this limitation. (App. Br. 24-26).
8 Kajikawa does disclose this limitation as already discussed. Therefore, the
9 Appellant has not shown that the Examiner erred in rejecting claims 6, 9, 11
10 and 14-16 under § 103(a).

11
12 **DECISION**

13 We AFFIRM the rejections of claims 1-6, 9-16, 19-23, 25 and 26.

14 No time period for taking any subsequent action in connection with
15 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
16 § 1.136(a)(1)(iv) (2007).

17
18 **AFFIRMED**

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20 vsh

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22
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